

App. No. 09/436,060
Response to Non-Final Office Action dated July 16, 2008

REMARKS/ARGUMENTS

Claims 35-39 and 42-45 are pending and under examination. Claims 1-34 and 40 - 41 are canceled.

Claim amendments

Claim 38 has been amended to delete the recitation of a specific sequence. No new matter is added by this amendment.

These amendments are made without prejudice to the filing of a continuation or continuation-in-part application directed to the canceled subject matter.

Information Disclosure Statement

Applicants enclose a copy of an Information Disclosure Statement and PTO-1449 form which was filed on January 12, 2000 and which does not appear to have been considered by the Examiner. The references were cited in U.S. Serial No. 08/770,564 from which this application claims priority and accordingly, no copies of reference need be provided. The Examiner is asked to consider and initial the form.

Applicants also enclose a new Information Disclosure Statement and Form citing one reference.

Allowable Subject Matter

Claims 38 and 39 were found allowable.

Claim Rejections 35 USC 102/103

Claims 35 -37 and 43-45 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,968,506 (the '506 patent). The '506 patent allegedly discloses a stand alone nucleotide (Oligo 14ab) which would specifically hybridize to nucleotides 361-380 of SEQ ID NO:16. The '506 patent allegedly discloses that the Oligo 14ab comprises biotinylated 2'-O-methyl ribonucleotides. It is the Examiner's position that the oligo is used in affinity

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chromatography and applied to a gel column equilibrated in buffer, which allegedly constitutes a pharmaceutically acceptable carrier.

Applicants maintain that the claims as recited are patentable for the following reasons.

Initially, Applicants note that US Patent No. 6,261,556 is a continuation of US Patent No. 5,968,506 (the '506 patent). US Patent No. 6,261,556 is cited in the enclosed Information Disclosure Statement.

The current patent application claims priority to US Patent Application No. 08/770,564 filed on December 20, 1996. The current claims are supported by the disclosure of US Patent Application No. 08/770,564 and are entitled to the priority date of December 20, 1996.

The '506 patent was filed on October 18, 1999. The priority date of the current application is before the filing date of the '506 patent and accordingly the '506 patent cannot act as a 102(e) reference against the current application as of its filing date. The '506 patent claims priority to U.S. Patent Application No. 08/510,736 filed on August 4, 1995 (the '736 application). However, **the '736 application does not teach or disclose Oligo 14ab.** Accordingly, the '506 patent is not a 102(e) reference against the current application.

Claims 35 -37 and 42-45 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,846,723 (the '723 patent). The '723 patent allegedly discloses Oligo 16 (SEQ ID NO: 5) which would hybridize to nucleotides 290-319 of SEQ ID NO:16 and Oligo 14ab.

Applicants maintain that the claims as recited are patentable for the following reason. The '723 patent was filed on December 20, 1996, which is the same day as Application No. 08/770,564 (the priority application of the current application). **The present application and the '723 patent have the same effective filing date,** and accordingly the disclosure of the patent cannot be used as prior art under 35 U.S.C. 102(e) against the current claims. *See Sarett, 327 F.2d at 1012-13, 140 USPQ at 481.*

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For these reasons, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. 103(e).

CONCLUSION

For the reasons provided above, Applicants respectfully request that all of the rejections be withdrawn and a Notice of Allowance issued.

The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account Number 07-1139.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-566-7106.

Respectfully submitted,



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